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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,076	11/13/2001	Jiro Senda	Q66742	6567
7590 03/24/2008 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3213				
EXAMINER GARCIA, GABRIEL I				
ART UNIT 2625		PAPER NUMBER		
MAIL DATE 03/24/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/987,076

**Applicant(s)**

SENDA, JIRO

**Examiner**

GABRIEL I. GARCIA

**Art Unit**

2625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 5, 8 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 8 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. This application has been examined, Claims 1,4,5,8 and 17-21 are pending in this application.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,4,5,8 and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Nihei (U.S. Patent Number 6,891,634, cited in the Office action dated 2/24/06).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Nihei discloses an image transmitting device (see Figs. 1-5) comprising combining process means for generating a composite image by joining a plurality of original images (**column 8, lines 31-59, describes how two images can be combine to form a composite image**), storing means for storing the composite image generated by the combining process means and the original images that the composite image comprises together with corresponding combining data required for generating the composite image (**column 8, lines 31-59**), and selection process means for executing a selection process that outputs one or more of the composite image, original images, or combining data as output data based on an output destination device specified as the destination for image transmission (**see Figs. 6-21, column 5, lines 11-49, and column 8, lines 31-59**), wherein the selection means further comprises: selecting output data based on predetermined based on the attributes of the output destination device (**reads on figs. 4 and 6, which depicts that a printer can be selected based on attribute(s) or capability of printer based in attribute such as how big the files are and the speed at which files are printed, clearly different printers have different attributes**).

Regarding claim 4, Nihei discloses the image transmitting device discussed above in claim 1 and further teaches that the selection process means executes the selection process

based on user specifications (see Figs. 6-21, column 5, lines 11-49, and column 7, line 21-column 8, line 59).

With Regard to claim 5, the limitations of claim 5 are covered by the limitations of claim 1 above.

With regard to claim 8, Nihei discloses the image transmitting method discussed above in claim 5, and further teaches that the selection process in the selection process step is executed based on user specifications (see Figs. 6-21, column 5, lines 11-49, and column 7, line 21-column 8, line 5).

With regard to claim 17, Nihei discloses wherein the election process means executes the selection process to selectively output one of the original images and combining and composite images based on properties of the output destination device (reads on figs. 4 and 6, which depicts that a printer can be selected based on properties or capability of each printer based in attribute such as how big the files are and the speed at which files are printed, clearly different printers have different properties).

With regard to claim 18, Nihei discloses a storage means comprises a single physical memory (reads on the different memories depicts in fig. 5).

With regard to claim 19, Nihei discloses a storage means is a harddisk (reads on item 36 in fig. 5).

With regard to claim 20, Nihei discloses wherein the images are obtained from a medical equipment or medical scanner (as suggested by Nihei in the abstract any type of image can be used to create the composite image as long as it can digitized).

With regard to claim 21, Nihei discloses the selection process means executes the selection process to selectively output two of original images and combining data and composite images based on properties of the output destination device (**reads on figs. 4 and 6, which depicts that a printer can be selected based on properties or capability of each printer based in attribute such as how big the files are and the speed at which files are printed, clearly different printers have different properties, and creating a composite image from different stored images see fig. 24).**

### ***Conclusion***

3. Applicant's added features to the claims have been addressed above.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (571) 272-7434. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is 571-273-8300.

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CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (**PAIR**) system Status information for published applications may be obtained from either Private **PAIR** or Public **PAIR**. Status information for unpublished applications is available through Private **PAIR** only. For more information about the **PAIR** system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private **PAIR** system, contact the Electronic Business Center (**EBC**) at 866-217-9197 (toll-free).

/Gabriel I Garcia/

Primary Examiner of Art Unit 2625

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**Gabriel I. Garcia**

**Primary Examiner**

**March 16, 2008**